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By

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: **DUDLEY ET AL.**

APPLICATION NO.: **10/038,006**

: Examiner: **Stockton, Laura**

FILING DATE: **JANUARY 4, 2002**

: Group Art Unit: **1626**

TITLE: **QUINOXALINONES AS SERINE:
PROTEASE INHIBITORS**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

This document responds to the Office Action in the above case mailed September 11, 2003 requesting a response by October 11, 2003. A Petition for a three-month extension of time accompanies this response, thereby extending the response date to January 11, 2003.

Reconsideration of the above application is respectfully requested.

Claims 1-48 are pending in the application. The Examiner has subjected the claims to restriction. Applicants respectfully elect Group I directed to claims 1-25 and 32 drawn to products. Applicants respectfully traverse herein below the Examiner's rejection of claims 26-31 and 33-48 on the grounds that the Examiner has not articulated why examining all of the pending claims in one application would be burdensome.

The Examiner has requested that Applicant elect a single species for prosecution. Applicant elects the species of Example 1, (i.e. 3-[3-((amidino)phenyl)-1-{5-[(2R,6S)-2,6-dimethylhexahydro-1-pyridinyl]pentyl}-1,2-dihydro-2-quinoxalinone).

Applicants traverse the Examiner's rejection on the grounds that it is improper and an abuse of discretion because prosecution of the restricted subject matter in one

application would not place a serious burden on the Examiner. M.P.E.P. § 803. According to M.P.E.P. § 803 the Examiner can only restrict patentably distinct inventions when (1) the inventions are independent or distinct as claimed and (2) where there is a serious burden on the Examiner if restriction is not required.

Applicants respectfully submit that the Examiner has made no showing that prosecuting the claims of the invention in one application would be burdensome. Applicants therefore submit that the Examiner's requirement of restriction is improper.

Furthermore, Applicants submit that the prosecution of all of the claims in the same application would not be burdensome because the Examiner would be required to search the same class and sub-class in order to determine patentability of any of Groups I to X. Furthermore, Applicants respectfully traverse the Examiner's restriction of the uses from the compounds. For the same reasons as above, the Examiner has all the relevant art in front of her. There is no burden of prosecuting the uses with the compounds or processes from compounds. Applicants specifically request that the Examiner at least reconsider her restriction and modify it so as to prosecute the uses with the compounds.

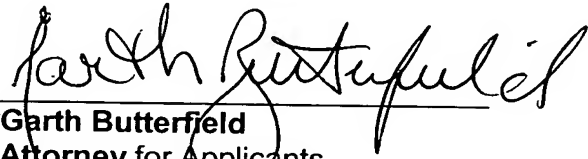
In view of the above, Applicants submit that the restriction requirement is improper and respectfully requests that the Examiner withdraw the restriction requirement so as to allow claims 1-48 to be prosecuted in the same application.

In conclusion, Applicants submit that all pending claims are patentable, and respectfully request that they be allowed to issue.

Respectfully submitted,

Date: December 22, 2003

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